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09/30/97

APPLICATION NO.

08/941,459

POKRZYWA, J

ARTUNIT PAPER NUMBER

2722

**DATE MAILED:** 

08/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks** 

# Office Action Summary

Application No. 08/941,459

Applicant

Morikawa, Takeshi

Examiner

Joseph Pokrzywa

Group Art Unit 2722



Responsive to communication(s) filed on Jun 15, 2000	
This action is FINAL.	
Since this application is in condition for allowance except for in accordance with the practice under <i>Ex parte Quayle</i> , 1935	formal matters, prosecution as to the merits is closed C.D. 11; 453 O.G. 213.
A shortened statutory period for response to this action is set to solven, from the mailing date of this communication. Failure to application to become abandoned. (35 U.S.C. § 133). Extension 37 CFR 1.136(a).	O respond within the period for response will cause the
Disposition of Claims	
	is/are pending in the application.
Of the above, claim(s)	
Claim(s)	
☐ Claims	
application Papers	·
☐ See the attached Notice of Draftsperson's Patent Drawing	Review, PTO-948.
☐ The drawing(s) filed on is/are objecte	d to by the Examiner.
☐ The proposed drawing correction, filed on	is bpproved disapproved.
$\hfill\Box$ The specification is objected to by the Examiner.	
$\square$ The oath or declaration is objected to by the Examiner.	
riority under 35 U.S.C. § 119	
Acknowledgement is made of a claim for foreign priority un	
	the priority documents have been
☑ received.	
☐ received in Application No. (Series Code/Serial Numb	
received in this national stage application from the Ir	nternational Bureau (PCT Rule 17.2(a)).
*Certified copies not received:  Acknowledgement is made of a claim for domestic priority	under 25 II C.C. \$ 440(a)
	under 35 0.5.C. § 119(e).
ttachment(s)	
<ul><li>☑ Notice of References Cited, PTO-892</li><li>☐ Information Disclosure Statement(s), PTO-1449, Paper Note</li></ul>	e)
Interview Summary, PTO-413	əi
□ Notice of Draftsperson's Patent Drawing Review, PTO-948	

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#### **DETAILED ACTION**

### Response to Amendment

1. Applicant's amendment was received on 6/15/00, and has been entered and made of record. Currently, claims 4 through 6, 13 through 16, and 23 through 30 are pending.

### Response to Arguments

- Applicant's arguments filed 6/15/00, with respect to amended independent claims 4, 13,
   and 28 have been fully considered but they are not persuasive.
- 3. After consideration of the amendment, the examiner notes that the amendment does not remedy the rejections, as cited in the Office action dated 3/13/00. Particularly, the rejection of claims 4, 13, and 28, as being anticipated by Oshita (U.S. Patent Number 5,343,306), wherein the claims were amended to read "a state decision controller for determining, for each frame, a state of a frame of said image data stored in the memory". Oshita teaches of a controller for determining, for each frame (column 5, lines 29 through 33, wherein a count value for each page is taken), a state of a frame of said image data stored in the memory (whereby the count value for one page is the state of a frame). Therefore, the added limitation of the amendment is still anticipated by Oshita.
- 4. In response to applicant's arguments on pages 6 through 8, stating that Oshita fails to teach of the claimed invention being "the state decision controller determines, for each frame, the

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state of the frame associated with the image data and then a comparison is made between at least two frames so that, as a result of the comparison, an inoperable mode is automatically prohibited". The examiner notes the present limitation of claims 4, 13, and 28, "a selection prohibiting controller for comparing the state of at least two frames, as determined by the state decision controller". The examiner agrees with applicant that Oshita fails to teach of comparing a state between at least two frames, but as noted, the claim limitation does not state this. The claim states of "comparing the state of at least two frames". Oshita teaches of comparing a state of a frame of image data to a length of a cut sheet, seen in column 5, lines 26 through 40. Further, Oshita teaches of comparing the state of a second frame of image data to the length of a cut sheet, seen in column 5, lines 50 through 63, therein repeating column 5, lines 26 through 41. Because of this, Oshita compares the state of at least two frames, granted, not to each other, but still "comparing the state of at least two frames", as required by the claim. The examiner recommends altering the wording of the limitation to avoid this confusion by possibly amending the claim to read "comparing the state [of] between at least two frames", or "comparing the state of [at least two frames] one frame with a state of at least one other frame".

5. Therefore, the rejection under 35 U.S.C. 102(b) of claims 4, 5, 13, and 28, as cited in the Office action dated 3/13/00, as being anticipated by Oshita (U.S. Patent Number 5,343,306) remain, and are repeated in this office action.

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- 6. In response to the amendment, claims 4, 13, and 28 were also rejected as being anticipated by Yoshida et al. (U.S. Patent Number 5,930,006). Yoshida's device may be materially different from the present invention, but it still anticipates claims 4, 13, and 28 as they are currently written. Particularly, Yoshida teaches of a controller (CPU 3, column 5, lines 27 through 32) for determining, for each frame, a state of a frame of the image data, seen in Fig. 21, wherein at step \$104, the judgment of character size determines the state of the document being input in step \$102, whereby the state of the document is in a landscape position or portrait position, column 11, lines 1 through 20 and column 15, lines 39 through 46, as well as the document containing the smallest character size having the highest possibility of impairing legibility of characters, seen in column 12, lines 29 through 38, whereby the state of the document is the degree of possibility for impairing the legibility of that document. Continuing, as seen in Fig. 21, at step \$109, the process returns to step \$102 to receive the next document or frame. whereby the state of that frame or document is determined at step S104, as discussed above. Therefore, it can be seen that Yoshida teaches of determining, for each frame, a state of a frame of image data, as required by the claim.
- 7. In response to applicant's arguments on pages 9 through 12, stating that Yoshida does not determine the state of the frame of the image data, much less compare the state of a first frame of image data to the state of at least one other frame of image data. The examiner notes the present limitation of claims 4, 13, and 28, "a selection prohibiting controller for comparing the state of at least two frames, as determined by the state decision controller". The examiner agrees with

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applicant that Yoshida fails to teach of comparing a state of a first frame of image data to the state of at least one other frame of image data, but as noted, the claim limitation does not state this. The claim states of "comparing the state of at least two frames". Yoshida teaches of comparing the state of a frame (character size L, which as discussed above determines the state of the frame, being the degree of possibility for impairing the legibility of that document in a landscape or portrait position) of image data to predetermined sizes (30, 40, 60, and 85, seen in Fig. 24, steps S404, S405, S406, and S407, respectively). Further, based on the above comparison, selection of an inoperable mode can be automatically prohibited at step S409 (setting Nin1 mode to "NG"). Returning to Fig. 21, once the state of the first frame is compared at steps \$105 and \$106, the process returns at step S109 to step S102, wherein a new, second frame is received, which the state of that frame or document is determined at step S104, and judged in steps S105 and S106, as discussed above. Therefore, it is seen that Yoshida compares the state of at least two frames. As expressed above, the examiner recommends altering the wording of the limitation to avoid this confusion by possibly amending the claim to read "comparing the state [of] between at least two frames", or "comparing the state of [at least two frames] one frame with a state of at least one other frame".

8. Therefore, the rejection under 35 U.S.C. 102(e) of claims 4, 5, 13, 27, and 28, as cited in the Office action dated 3/13/00, as being anticipated by Yoshida *et al.* (U.S. Patent Number 5,930,006) remain, and are repeated in this office action.

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- In response to applicant's arguments on pages 12 through 14, regarding the rejection of claim 23 as being unpatentable over Collard et al. (U.S. Patent number 5,825,988) in view of Yoshida et al. (U.S. Patent number 5,930,006), stating that Yoshida does not determine the state of the frame of the image data, and does not compare the determined state of a frame to the determined state of at least one other frame of image data. The examiner notes the wording of the current claim limitation, stating "comparing the state of at least two frames". As discussed above, with respect to claims 4, 13, and 28, and using the same response, Yoshida teaches of the limitation which is deficient in Colllard, notably, Yoshida teaches of a controller for comparing the state of at least two frames, as determined by the state decision controller, and for automatically prohibiting selecting an inoperable print mode based on the result of the comparison.
- Therefore, the rejection under 35 U.S.C. 103(a) of claim 23, as cited in the Office action dated 3/13/00, as being unpatentable over Collard *et al.* (U.S. Patent number 5,825,988) in view of Yoshida *et al.* (U.S. Patent Number 5,930,006) remain, and are repeated in this office action.

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## Claim Rejections - 35 USC § 102

- 11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- 12. Claims 4 through 6, 13, 28, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Oshita (U.S. Patent Number 5,343,306, cited in the Office action dated 3/13/00).

Regarding *claim 4*, Oshita discloses an image processing device (facsimile machine, column 1, lines 46 through 53) operable in a plurality of modes of operation (transmitting or receiving modes), comprising a memory (page memory 102) for storing image data of a plurality of frames (column 3, lines 16 and 17, wherein a plurality of frames or pages of documents are stored in the page memory, see column 8, lines 3 through 17), a controller (line counter 107, column 3, lines 48 through 51) for determining, for each frame, a state of a frame of the image data (column 5, lines 26 through 33), an operation panel (manual input section 108) for selecting any of the plurality of modes of operation (column 4, lines 1 through 6), and a controller (controller 10, column 2, lines 32 through 40) for comparing the state of at least two frames, as determined by the state decision controller (column 5, lines 26 through 41, wherein the length of at least two sheets are compared to the currently loaded cut sheet length), and for automatically prohibiting selecting an inoperable mode (column 5, lines 42 through 49) of operation of the plurality of modes of operation through the operation panel based on the result of the comparison (column 5, line 64 through column 7, line 20).

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Regarding *claim 5*, Oshita discloses the image processing device discussed in claim 4, and further teaches of the decision controller determines a length of a frame of the image data in a predetermined direction (column 3, lines 48 through 51).

Regarding *claim* 6, Oshita discloses the image processing device discussed in claim 4, and further teaches of the decision controller determines a frame size of the frame of the image data (column 5, lines 26 through 41, wherein the count value at the end of each document page represents the effective document page length, therein determining a frame size).

Regarding *claim 13*, Oshita discloses an image forming apparatus (facsimile machine, column 1, lines 46 through 53) operable in a plurality of print modes (letter size mode and legal size mode), comprising a memory (page memory 102) for storing image data of a plurality of frames (column 3, lines 16 and 17, wherein a plurality of frames or pages of documents are stored in the page memory, see column 8, lines 3 through 17), a printer (printer 110) for reading the image data stored in the memory for each frame and for printing (column 3, lines 52 through 68), a controller (line counter 107, column 3, lines 48 through 51) for determining, for each frame, a state of a frame of the image data (column 5, lines 26 through 33), an operation panel (manual input section 108) for selecting any of the plurality of print modes (column 4, lines 1 through 6, and column 6, lines 24 through 40, wherein the START key is pressed after changing paper), and a controller (controller 10, column 2, lines 32 through 40) for comparing the state of at least two frames, as determined by the state decision controller (column 5, lines 26 through 41, wherein the length of at least two sheets are compared to the currently loaded cut sheet length), and for

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automatically prohibiting selecting an inoperable print mode (column 5, lines 42 through 49) of the plurality of print modes through the operation panel based on the result of the comparison (column 5, line 64 through column 6, line 35, column 6, line 64 through column 7, line 20).

Regarding claim 28, Oshita discloses an image processing device (facsimile machine, column 1, lines 46 through 53) operable in a plurality of modes of operation (transmitting or receiving modes), comprising a memory (page memory 102) for storing image data of a plurality of frames (column 3, lines 16 and 17, wherein a plurality of frames or pages of documents are stored in the page memory, see column 8, lines 3 through 17), a controller (line counter 107, column 3, lines 48 through 51) for determining, for each frame, a state of a frame of the image data (column 5, lines 26 through 33), a controller (controller 10, column 2, lines 32 through 40) for comparing the state of at least two frames, as determined by the state decision controller (column 5, lines 26 through 41, wherein the length of at least two sheets are compared to the currently loaded cut sheet length), and for automatically prohibiting selecting an inoperable mode (column 5, lines 42 through 49) of operation of the plurality of modes of operation through the operation panel based on the result of the comparison (column 5, line 64 through column 6, line 35, column 6, line 64 through column 7, line 20), and an operation panel (manual input section 108), responsive to the selection prohibiting controller, for selecting any of the plurality of modes of operation, with the operation panel automatically prohibiting selecting the thus determined inoperable mode of operation (column 4, lines 1 through 14, and column 6, lines 7 through 45).

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Regarding *claim 29*, Oshita discloses the image processing device discussed in claim 28 above, and further teaches of the state of the frame of the image data determined by the state decision controller for each frame thereof is a frame size (column 5, lines 26 through 41, wherein the count value at the end of each document page represents the effective document page length, therein determining a frame size).

13. Claims 4, 5, 13, 27, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoshida *et al.* (U.S. Patent Number 5,930,006, cited in the Office action dated 3/13/00).

Regarding *claim 4*, Yoshida discloses an image processing device operable in a plurality of modes of operation ("Nin1" operations, such as 2in1 or 4in1, etc., shown in Fig. 24), comprising a memory (multiport image memory 304 within memory 30, see Fig. 5) for storing image data of a plurality of frames (column 6, lines 47 through 51, wherein two frames or pages are stored, and column 7, lines 25 through 28), a controller (CPU 3, column 5, lines 27 through 32) for determining, for each frame, a state of a frame of the image data (column 6, lines 58 through column 7, line 2, and see Fig. 23, column 15, lines 37 through 46), an operation panel (shown in Fig. 7) for selecting any of the plurality of modes of operation (column 8, line 62 through column 9, line 20), and a controller (CPU3, column 5, lines 27 through 32) for comparing the state of at least two frames (column 14, lines 19 through 46, and particularly column 16, lines 17 through 55, wherein the character size of one document is compared to predetermined pixels, and then repeated for a second document, thus comparing at least two frames), as determined by

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the state decision controller (steps S106 in Fig. 21, Fig. 24, and steps S609, S613, S615 in Fig. 26), and for automatically prohibiting selecting an inoperable mode of operation of the plurality of modes of operation through the operation panel based on the result of the comparison (column 14, lines 6 through 18, and steps S616 and S617 in Fig. 26, column 19, lines 14 through 21).

Regarding *claim 5*, Yoshida discloses the image processing device discussed in claim 4, and further teaches of the decision controller determines a length of a frame of the image data in a predetermined direction (column 10, lines 3 through 7, and Fig. 14, which shows the page length in the main scanning direction, and the length in the sub-scanning direction).

Regarding *claim 13*, Yoshida discloses an image forming apparatus operable in a plurality of print modes ("Nin1" operations, such as 2in1 or 4in1, etc., shown in Fig. 24), comprising a memory (multiport image memory 304 within memory 30, see Fig. 5) for storing image data of a plurality of frames (column 6, lines 47 through 51, wherein two frames or pages are stored, and column 7, lines 25 through 28), a printer for reading the image data stored in the memory for each frame and for printing (print processing part PRT 40, column 4, line 63 through column 5, line 10), a controller (CPU 3, column 5, lines 27 through 32) for determining, for each frame, a state of a frame of the image data (column 6, lines 58 through column 7, line 2, and see Fig. 23, column 15, lines 37 through 46), an operation panel (shown in Fig. 7) for selecting any of the plurality of print modes (column 8, line 62 through column 9, line 20), and a controller (CPU3, column 5, lines 27 through 32) for comparing the state of at least two frames (column 14, lines 19 through 46, and particularly column 16, lines 17 through 55, wherein the character size of one document is

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compared to predetermined pixels, and then repeated for a second document, thus comparing at least two frames), as determined by the state decision controller (steps S106 in Fig. 21, Fig. 24, and steps S609, S613, S615 in Fig. 26), and for automatically prohibiting selecting an inoperable print mode of the plurality of print modes through the operation panel based on the result of the comparison (column 14, lines 6 through 18, and steps S616 and S617 in Fig. 26, column 19, lines 14 through 21).

Regarding *claim 27*, Yoshida discloses the image processing device discussed in claim 4 above, and further teaches of a display for displaying an operating state of the image processing device (LCD panel, column 9, lines 1 through 15), and a controller (CPU1), responsive to the selection prohibiting controller, for displaying on the display an operable mode of operation of the plurality of modes operation (column 5, lines 20 through 22, and column 8, line 62 through column 9, line 20).

Regarding *claim 28*, Yoshida discloses an image processing device operable in a plurality of modes of operation ("Nin1" operations, such as 2in1 or 4in1, etc., shown in Fig. 24), comprising a memory (multiport image memory 304 within memory 30, see Fig. 5) for storing image data of a plurality of frames (column 6, lines 47 through 51, wherein two frames or pages are stored, and column 7, lines 25 through 28), a controller (CPU 3, column 5, lines 27 through 32) for determining, for each frame, a state of a frame of the image data (column 6, lines 58 through column 7, line 2, and see Fig. 23, column 15, lines 37 through 46), a controller (CPU3, column 5, lines 27 through 32) for comparing the state of at least two frames (column 14, lines 19

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through 46, and particularly column 16, lines 17 through 55, wherein the character size of one document is compared to predetermined pixels, and then repeated for a second document, thus comparing at least two frames), as determined by the state decision controller (steps S106 in Fig. 21, Fig. 24, and steps S609, S613, S615 in Fig. 26), and for automatically prohibiting selecting an inoperable mode of operation of the plurality of modes of operation through the operation panel based on the result of the comparison (column 14, lines 6 through 18, and steps S616 and S617 in Fig. 26, column 19, lines 14 through 21), and an operation panel (shown in Fig. 7), responsive to the selection prohibiting controller, for selecting any of the plurality of modes of operation, with the operation panel automatically prohibiting selecting the thus determined inoperable mode of operation (column 8, line 62 through column 9, line 20, and column 14, lines 13 through 18).

### Claim Rejections - 35 USC § 103

- 14. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- 15. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Collard et al. (U.S. Patent Number 5,825,988, cited in the Office action dated 3/13/00) in view of Yoshida et al. (U.S. Patent Number 5,930,006, cited in the Office action dated 3/13/00).

Regarding *claim 23*, Collard discloses an image forming apparatus operable in a plurality of print modes (see Figs. 6A and 6B, digital, 2-sided, and 1-sided modes), comprising a memory (central storage means 15, or memory disc 23) for storing a plurality of print jobs (column 5, lines

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9 through 61), each print job containing image data of at least two frames (column 5, lines 20 through 29), a selector for selecting one of the plurality of print jobs stored in the memory (column 7, lines 18 through 27), a controller (control module 18) for determining, for each frame, a state of a frame of the image data contained in the print job selected by the print-job selector (column 7, lines 28 through 37), a printer (printing unit 3) for printing the image data contained in the print job selected by the print-job selector (column 4, lines 15 through 60), and an operation panel (panel 19) for selecting any of the plurality of print modes (column 6, lines 10 through 65), and a controller (control unit 18) for selecting a print mode of the plurality of print modes through the operation panel based on the thus determined state of the image data contained in the print job selected by the print-job selector (column 4, line 61 through column 5, line 8, and column 7, lines 33 through 63). However, Collard fails to teach of the controller for comparing the state of at least two frames, as determined by the state decision controller, and for automatically prohibiting selecting an inoperable print mode based on the result of the comparison.

Yoshida discloses an image forming apparatus operable in a plurality of print modes ("Nin1" operations, such as 2in1 or 4in1, etc., shown in Fig. 24), comprising a memory (multiport image memory 304 within memory 30, see Fig. 5) for storing image data of at least two frames (column 6, lines 47 through 51, wherein two frames or pages are stored, and column 7, lines 25 through 28), a controller (CPU 3, column 5, lines 27 through 32) for determining, for each frame, a state of a frame of the image data (column 6, lines 58 through column 7, line 2, and see Fig. 23, column 15, lines 37 through 46), a printer for printing the image data stored in the memory for

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each frame and for printing (print processing part PRT 40, column 4, line 63 through column 5, line 10), an operation panel (shown in Fig. 7) for selecting any of the plurality of print modes (column 8, line 62 through column 9, line 20), and a controller (CPU3, column 5, lines 27 through 32) for comparing the state of at least two frames (column 14, lines 19 through 46, and particularly column 16, lines 17 through 55, wherein the character size of one document is compared to predetermined pixels, and then repeated for a second document, thus comparing at least two frames), as determined by the state decision controller (steps S106 in Fig. 21, Fig. 24, and steps S609, S613, S615 in Fig. 26), and for automatically prohibiting selecting an inoperable print mode of the plurality of print modes through the operation panel based on the result of the comparison (column 14, lines 6 through 18, and steps S616 and S617 in Fig. 26, column 19, lines 14 through 21). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Yoshida's teachings within Collard's system. Collard's system could easily be modified to include Yoshida's teachings since both systems share cumulative features.

16. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oshita (U.S. Patent Number 5,343,306, cited in the Office action dated 3/13/00) in view of Yoshida *et al.* (U.S. Patent Number 5,930,006, cited in the Office action dated 3/13/00).

Regarding *claim 30*, Oshita discloses the image processing device discussed in claim 29 above, but fails to teach of the plurality of modes of operation including at least one specifically

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noted as an economy print mode, or for that matter a two-side print mode or a staple print mode. Yoshida discloses an image processing device operable in a plurality of modes of operation ("Nin1" operations, such as 2in1 or 4in1, etc., shown in Fig. 24), and further teaches of the plurality of modes of operation include at least one of economy print mode (economized Nin1 function, column 9, lines 46 through 57), two-side print mode, and staple print mode. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Yoshida's economy print mode in Oshita's system. Oshita's system would become more efficient with the addition of Yoshida's teachings of an economized print mode, as the apparatus would select the most appropriate output paper size.

### Allowable Subject Matter

17. Claims 14 through 16, and 24 through 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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## Citation of Pertinent Prior Art

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Obara (U.S. Patent Number 5,544,875) discloses a system of inhibiting the use of a stacker of an image processing apparatus based on a comparison of paper size; and

**Kageyama** et al. (U.S. Patent Number 5,265,209) discloses a system of printing pages having different page sizes, wherein an input page size is compared to a default page size, seen in Fig. 6(c2), step 643.

#### Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action, with respect to dependent claims 6, 29, and 30. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

20. Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner

can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Edward Coles, can be reached on (703) 305-4712. The fax phone number for this Group is

(703) 306-5406.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the Group receptionist whose telephone number is (703) 305-3800/4700.

Joseph R. Pokrzywa

August 18, 2000

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